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IN THE

Supreme Court of the United States

October Term, 1946
No. 1273-1274

REFRIGERATION PATENTS CORPORATION,
Petitioner,

against

STEWART-WARNER CORPORATION,
Respondent.

POTTER REFRIGERATOR CORPORATION,
Petitioner,

against

STEWART-WARNER CORPORATION,
Respondent.

PETITION FOR WRITS OF CERTIORARI TO THE UNITED STATES CIRCUIT COURT OF APPEALS FOR THE SEVENTH CIRCUIT AND BRIEF IN SUPPORT THEREOF

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PETITION FOR WRITS OF CERTIORARI

To the Honorable, the Chief Justice and Associate Justices of the Supreme Court of the United States:

Your petitioners, Refrigeration Patents Corporation and Potter Refrigerator Corporation, respectively pray for writs of certiorari to the United States Circuit Court of Appeals for the Seventh Circuit to review its decision filed February 4, 1947 herein which overrode jury verdicts.

A certified transcript of the combined record in these two cases (tried together before the same jury), and the proceedings in the Circuit Court of Appeals, is furnished herewith pursuant to Rule 38 of this Court.[1]

Summary Statement of the Matter Involved

These are two actions at law, under R.S. 4919, 35 U.S.C. §67, wherein petitioner Refrigeration Patents Corporation charged respondent Stewart-Warner Corporation with infringing patent No. 2,056,165 to Bronaugh and Potter (R. IV, pp. 2686-91), and petitioner Potter Refrigerator Corporation charged respondent Stewart-Warner Corporation with infringing patents Nos. 2,171,712 and 2,258,959 both to Potter (R. IV, pp. 2694-2705).

After a seven weeks trial in Chicago before Judge LaBuy and a jury, the jury rendered three verdicts whereby they found:

(1) Stewart-Warner Corporation guilty as to patent 2,056,165 and assessed damages of $225,000 (R. IV, p. 2620).

(2) Stewart-Warner Corporation guilty as to patent 2,171,712 and assessed damages of $13,000 (R. IV, p. 2622).

(3) Stewart-Warner Corporation not guilty as to patent 2,258,959 (R. IV, p. 2621).

At the close of petitioners' evidence and again at the close of all the evidence, motions of Stewart-Warner Corporation for directed verdicts were denied (R. IV, pp. 2589-90, 2592; 2618-9). After entry of judgments, Stewart-War-

[1] The record is in four volumes and all references herein are to volume and page number.

ner Corporation moved for a new trial and for judgment notwithstanding the verdicts. Both motions were denied (R. IV, pp. 2627-31), as was also its petition for rehearing (R. IV, pp. 2631, 2636-7).

Judge LaBuy's memorandum on that petition (R. IV, pp. 2635-6) states as follows:

> "These cases were submitted to the jury (having been tried together) on the questions of the validity of the claims in suit of said patents Nos. 2,056,165 and 2,171,712, and of the infringement of said claims by the defendant; the trial of said issues lasted for almost seven weeks in open Court; a great deal of evidence was offered by the parties to the suits, and submitted to the jury in the two cases, in open Court, including the oral testimony and the depositions of a large number of witnesses, and numerous exhibits, both paper and physical; the jury was carefully charged by the Court as to the law on the issues involved; the charge given by the Court to the jury was gone over with counsel for the parties by the Court at great length before the charge was read to the jury; and the jury returned their verdicts finding the claims in suit of said patents Nos. 2,056,165 and 2,171,712 valid and infringed.
>
> "The Court, as well as the jury, saw the witnesses, heard their testimony, and had full opportunity to observe their demeanor on the witness stand. The credibility of the witnesses and the weight to be given to their testimony were matters for the jury to determine and give consideration to, and arrive at their verdicts. The verdicts, as rendered, are amply supported by the evidence, and by the predominant weight of the evidence introduced.
>
> "The Court is of the opinion that the validity and infringement of the claims in suit of said two

> patents have been fully established by a clear preponderance of all the evidence offered and received during the trial; * * * the Court is of the opinion that the verdicts of the jury in finding validity, of the claims in suit of said patents Nos. 2,056,165 and 2,171,712, and their infringement by the defendant, are fully justified by the evidence."

Respondent appealed and the Circuit Court of Appeals for the Seventh Circuit rendered its opinion February 4, 1947 reversing the two judgments for petitioners.[2] In that opinion (R. IV, pp. 2776-86, so far reported only in 72 USPQ 255) the court concluded that, notwithstanding "the trial judge's admirable exposition of patent law", there was no instruction to the jury in respect of the particular requirement of sufficiency of description of a claim under R. S. 4888, 35 U. S. C. §33, and that such issue of fact was therefore ignored by the jury, and hence, was open for determination by the appellate court (R. IV, pp. 2780-81). The court then proceeded to hold patents Nos. 2,056,165 and 2,171,712 invalid as a matter of law for failure of the claims to comply with the statute (R. IV, pp. 2781-86). In this connection the court relied only on the decision of this Court in *Halliburton Oil Well Cementing Co.* v. *Walker*, 329 U. S. 1, rendered after submission of this case to the appellate court. Petitioners requested but were denied an opportunity to be heard on the meaning or inappositeness of that decision.

The instructions to the jury appear in the record at volume III, pages 1871 to 1893. The instructions with re-

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[2] Petitioner, Potter Refrigerator Corporation, took no appeal from that part of the Judgment (R. IV, pp. 2622-3) which held no recovery should be had on patent 2,258,959.

spect to the requirements of R. S. 4888, 35 U. S. C. §33 appear at pages 1873-4, which in part are in the precise words of that statute, and where they deviate, the departure transcends the rigor of that statute.[3] The instructions on this point were in the form submitted by respondent and it requested no different or additional instructions thereon. There was no objection or claim of misdirection or non-direction by respondent.

Jurisdiction

The judgments of the Circuit Court of Appeals were entered February 4, 1947 (R. IV, pp. 2787-8); and a petition for rehearing was denied without opinion on March 20, 1947 (R. IV, p. 2790). The jurisdiction of this Court is invoked under Section 240(a) of the Judicial Code as amended by Act of February 13, 1925.

Questions Presented

1. In the absence of any objection to instructions delivered by a United States District Court to a jury, *and* in the absence of any request for any additional instruction, may a Circuit Court of Appeals, on the basis of its conclusion that no instruction was delivered in respect of a specified issue of fact within the compass of a general verdict rendered by the jury, re-examine that issue of fact and overturn the verdict by substituting its own findings therefor?

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[3] The complete statute appears as an appendix to the supporting brief.

2. In an action at law for patent infringement tried before a jury, where validity of the patent has been challenged on the ground of non-compliance with the requirements of R. S. 4888, 35 U. S. C. §33 and on other grounds; where the jury has been instructed it cannot find infringement unless it also finds validity; where no objection has been taken to the charge given to the jury; where no request has been made for any additional or any different charge; where the jury, following a charge (not within the purview of Rule 49, Rules of Civil Procedure), rendered a general verdict that the patent has been infringed and assessed the infringement damages; and where, on the appeal from the judgment entered on such general verdict, appellant raised no question as to the correctness and completeness of the jury charge,—may a United States Circuit Court of Appeals, by asserting total non-direction to the jury in respect of said statute, pass on that fact issue as matter of law, and as matter of law hold the patent invalid, and reverse the judgment entered on the general verdict of the jury?

3. (For clarification of the decision of this Court in *Halliburton Oil Well Cementing Co.* v. *Walker,* 329 U. S. 1)—Did the court below correctly interpret and apply this Court's decision in the *Halliburton* case to require the holding that *new combinations* of a plurality of elements, each element being earlier well-known separately and in different associations, are not validly patentable under R. S. 4888, 35 U. S. C. §33 unless the patent claims are verbally limited to the *particular embodiment of each element* selected by the patentee for illustration of one embodiment of his invention wherein novelty resided not in any *particular element* but in *the particular combination*?

Reasons Relied on for the Allowance of the Writs

1. This is a case of peculiar gravity and general importance for it involves the construction and application of the Seventh Amendment to the Constitution.

Petitioners brought these actions at law before a jury for the reason that infringement at the time had ceased because of war restrictions prohibiting refrigerator manufacture. Petitioners were entitled under the Seventh Amendment to have all issues of fact submitted to the jury. Neither party at the trial or on the appeal questioned that all such issues had been submitted to the jury. Accordingly, the appellate court could not re-examine any fact issue otherwise than according to the rules of the common law without violating the Seventh Amendment.

The Circuit Court of Appeals has dealt with an issue of fact, which it deemed was not submitted to the jury, as an issue of law for appellate determination. It has dealt with general verdicts as though they were special verdicts.

2. The Seventh Circuit Court of Appeals palpably erred when it stated that no direction was given to the jury in respect of the legal requirements of R. S. 4888, 35 U. S. C. §33. The jury charge plainly shows that statement to be untrue.

3. Direct conflict exists between the decision sought to be reviewed and applicable decisional law of this Court.

Contrast the holding herein as follows:

> "We conclude that where, as here, there was no instruction on the matter, the issue was ignored and therefore must be determined by this court."

with the holdings of this Court, as follows:

> "But it is no ground of reversal, that the court below omitted to give directions to the jury upon any points of law which might arise in the cause, where it was not requested by either party, at the trial. It is sufficient for us, that the court has given no erroneous directions. If either party deems any point presented by the evidence to be omitted in the charge, it is competent for such party to require an opinion from the court upon that point; if he do not, it is a waiver of it."
>
> *Pennock* v. *Dialogue*, 27 U. S. 1, 15.
>
> "This point [compliance of a patent with the statutory requirements] does not appear to have been taken in the court below, and, therefore, cannot be made here. No instruction was asked or given touching the subject. It is to be presumed, until the contrary is made to appear, that the commissioner did his duty correctly in granting the reissued patent."
>
> *Klein* v. *Russell*, 86 U. S. 433, 463.

If the precedents of this Court are not entitled to respect in appraising rights for determining business conduct and the conduct of litigation, it is believed this Court should be the tribunal to announce the change. The court below has disregarded petitioners' constitutional rights by disregarding a rule of law settled by uniform decisions of this Court.

4. The decision below erroneously construes and extends the doctrine announced by this Court in *Halliburton Oil Well Cementing Co.* v. *Walker*, 329 U. S. 1.

The *Halliburton* decision has gravely disturbed the patent bar generally. Not the least of such concern has arisen

from its apparent susceptibility to differing and unpredictable interpretations by the lower courts. Indeed, the Seventh Circuit Court of Appeals itself has since furnished a conspicuous example of the unpredictability of judicial holdings in the commonest class of patent cases, namely, those where the patented invention resides in combining a plurality of individually old elements into a new combination possessing new utility.

Less than one month before the decision herein, the same court rendered its opinion in *Minnesota Mining & Mfg. Co.* v. *International Plastic Corp.*, 159 F. (2d) 554, 558. In that case, the court held the rule of the *Halliburton* decision inapplicable and sustained the patent. In the present, it held the rule applicable and invalidated the patents. The two opinions are inconsistent, and leave the patent bar and the public in serious doubt as to what the law is in the Seventh Circuit and as to what it will be held to be in other circuits. For example, in the *Minnesota Mining* case, the court held a claimed characterization of a tape adhesive as "non-offsetting" to comply with the statutory demands for exactness. In the present case, the same court held a claimed characterization of a refrigerator coil as "non-frosting" to be a non-compliance. The conflict between the two opinions urgently calls for the granting of the petition herein and the removal by this Court of the confusion now facing patentees and the public generally.

5. The patents in suit (No. 2,056,165 in particular) are of great importance. As granted, patent 2,056,165 was intended to, and does, cover an invention of wide-spread adoption in the post-war domestic refrigerator industry. Petitioners have substantially exhausted their resources

in conducting the litigation herein to date. Petitioners and the industry generally should have the benefit of a prompt and final determination by this Court of the validity of said patent.

WHEREFORE, your petitioners respectfully pray that writs of certiorari be issued to the United States Circuit Court of Appeals for the Seventh Circuit to the end that these causes may be reviewed and determined by this Court, that the judgments of the Circuit Court of Appeals may be reversed and the judgments of the District Court affirmed; and that petitioners may be granted such other and further relief as may seem proper.

LEONARD A. WATSON,
Counsel for Petitioners.

ELMER R. HELFERICH,
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BRIEF IN SUPPORT OF PETITION FOR WRITS OF CERTIORARI

Opinions of the Courts Below

The District Court wrote no formal opinion but filed a memorandum stating its reasons for refusing to direct verdicts, or grant a new trial, or grant judgments notwithstanding the verdicts (R. IV, pp. 2635-6). The opinion of the Circuit Court of Appeals has not been officially reported but is printed in Volume IV of the record at pages 2776 to 2786 and in 72 USPQ 255.

Jurisdiction

The jurisdiction is stated in the petition at page 5.

Statement of the Case

The essential facts are stated in the Summary Statement of the Matter Involved in the accompanying petition for writ of certiorari.

Specification of Errors

The errors which petitioners will urge if the writ of certiorari is issued are that the Seventh Circuit Court of Appeals erred:

1. In treating as an issue of law open to appellate determination what this Court has held to be an issue of fact to be determined only by the jury and in disregarding and violating the Seventh Amendment to the Constitution.

2. In proceeding on the erroneous assumption, that such issue of fact was totally ignored in the charge to the jury and not submitted to the jury.

3. In disregarding decisional and rule law of this Court which forbids an appellate court to reverse the jury upon an omission of an instruction not requested by either party.

4. In misinterpreting the decision of this Court in *Halliburton Oil Well Cementing Co.* v. *Walker,* 329 U. S. 1, to require the conclusion that the patents here in suit are, or that either patent is, invalid for failure to comply with R. S. 4888, 35 U. S. C. §33.

Summary of Argument

The argument will discuss the reasons relied on for the allowance of the writ.

Argument

1. The two cases for which writs are sought are actions on the case involving two patents. Since 1819 a patentee has had the right to elect to sue for infringement at law or in equity. *Tucker* v. *Spalding*, 80 U. S. 453, 455. A jury trial was had here because there was no need for an injunction but great need of avoiding the expense and delays of an accounting. In these actions it was the province of the jury to pass on *all* issues of fact. *Hodges* v. *Easton*, 106 U. S. 408, 412.

It is a fundamental principle that under proper instructions validity and infringement are questions of fact for the jury.

> "Validity and infringement are ultimate facts on which depends the question of liability. In actions at law they are to be decided by the jury."
>
> *U. S.* v. *Esnault-Pelterie*, 299 U. S. 201, 205.

At the conclusion of the seven weeks trial all issues were submitted to the jury and instructions were given by the trial court in a charge to which there was no objection by either party. Nor did either party request any additional instructions. The verdicts of the jury in favor of petitioners thus decided the issues of validity of the patent claims in suit and their infringement by respondent, as "ultimate facts".

The Seventh Amendment to the Constitution provides:

> "In Suits at common law, where the value in controversy shall exceed twenty dollars, the right of trial by jury shall be preserved, and no fact tried by a jury, shall be otherwise re-examined in any Court of the United States, than according to the rules of the common law."

The Circuit Court of Appeals ignored this and held that it was free to consider and determine whether the patent claims in suit complied with the statutory requirements of particularity (R. S. 4888, 35 U. S. C. §33) on the ground that the trial judge had omitted from his charge to the jury any "instruction on the matter" (R. IV, pp. 2780-81). The court then proceeded to re-examine and determine, adversely to petitioners, the jury's finding of fact that the patents were valid. In doing so, the court failed to abide by the Seventh Amendment to the Constitution quoted above.

2. As a stated premise to its unrestrained freedom to disregard the jury's findings of validity, the court below stated:

> "We have carefully studied the trial judge's admirable exposition of patent law in his instructions to the jury in the instant case. * * * but he nowhere cited this requirement [The patentee 'shall particularly point out and distinctly claim the part, improvement or combination which he claims as his invention.'] of the statute, or its phraseology, nor did he submit that phase of the issue of their validity to them for their consideration and determination. * * *
>
> "* * * there has been no determination of the validity of the claims, as to their sufficiency under

the statute, unless such conclusion be inherent in a verdict and judgment of recovery against the defendant. We conclude that where, as here, there was no instruction on the matter, the issue was ignored and therefore must be determined by this court" (R. IV, pp. 2780-81; 72 USPQ 255, 257-8).

To the contrary the instructions of the trial judge to the jury include the following (R. III, pp. 1871-1893):

> "The court will instruct you as to the law and the interpretation of the three patents concerned.
>
> You are the sole judge of the facts and you must apply to the facts the law and the interpretation of the patents as I shall explain them" (p. 1872).
>
> • • • •
>
> "Under the Constitution of the United States and under laws enacted by Congress, the government upon compliance with the laws and the regulations under the laws, grants patents for inventions. • • • They are presumed to be valid, but that presumption can be overcome and the patents held to be invalid if they do not fulfill or come up to legal standards and requirements. • • • It is the law that after a man has illustrated and described his device, he must particularly point out and distinctly claim the part, improvement or combination which he claims as his invention. • • • when it comes to the claims, he must there define or describe his exact invention so as clearly to distinguish it from what was old, that is, from what existed before his invention. • • • He can claim only the thing which he has invented and his claims must define that particular thing so that the public will know what that thing is and be able to avoid infringing it.
>
> The function of a patent claim is not merely to outline or to summarize what is shown and described, but rather to define the exact boundaries of the in-

> vention,—that is to determine with precision or to mark out clearly the boundaries or limits of the invention" (pp. 1873-74).

In view of this charge, the conclusion of the Circuit Court of Appeals that the jury was not instructed with respect to the statutory requirements for particularity and clarity of claim is plain error. What the Circuit Court of Appeals did by independently determining a question of fact, which it admits in its opinion was for determination by the jury, was tantamount to withdrawing that question from the jury and usurping its functions. "The right to trial by jury is a 'basic and fundamental feature of our system of federal jurisprudence'." *Bailey* v. *Central Vermont Ry.*, 319 U. S. 350, 353-4. If appellate courts can thus, by *ipse dixit*, circumvent jury verdicts, then one of the fundamental constitutional safeguards is ineffective against judicial caprice. Error on the face of the opinion frequently has been deemed ground for the grant of certiorari. See *Jurisdiction of the Supreme Court of the United States* (1936) by *Robertson and Kirkham*, §304, pp. 610, 613-5.

The case at bar is not the first wherein the Circuit Court of Appeals for the Seventh Circuit has ventured without right to undo the general verdict of a jury. In the following recent cases certiorari has been granted and the decisions of the Seventh Circuit Court of Appeals reversed for improperly dealing with jury verdicts:

> *U. S. ex rel. Willoughby* v. *Howard*, 302 U. S. 445;
> *Equitable Co.* v. *Halsey, Stuart & Co.*, 312 U. S. 410;
> *United States* v. *Johnson*, 319 U. S. 503;
> *Tennant* v. *Peoria & P. U. Ry. Co.*, 321 U. S. 29;
> *Bigelow* v. *RKO Radio Pictures*, 327 U. S. 251.

3. Furthermore, even if it be assumed that the trial judge omitted to charge the jury as to the statutory demands for clarity and exactness of patent claim, still, under the settled law of this Court, the Circuit Court of Appeals was not free independently to consider and determine the question of compliance of the patents with the statutory requirements.

The opinion below correctly states that the defenses of invalidity under R. S. 4888, 35 U. S. C. §33 were raised in the respondent's answers (R. IV, p. 2781). It fails to remark that such affirmative defenses stood denied under Rule 8 of the Rules of Civil Procedure. Thus issue was drawn and validity of the patents on that issue was a question of fact for the jury.

Patents when issued carry the presumption of compliance with *all* the statutory prerequisites necessary to their grant and validity.

Agawam Company v. *Jordan*, 74 U. S. 583, 597.

Not only was the challenge of the answers as to sufficiency of description under R. S. 4888, 35 U. S. C. §33 rebutted by the denial under Rule 8, and by the presumption of full compliance with that Statute, according to *Agawam, supra*, but actually, although respondent had the burden of proof to support this challenge and overcome this presumption, petitioners also, and prior to respondent, presented evidence on this precise issue of fact for consideration by the jury (R. I, 123-8; 133-46; 185-213), and the jury considered that evidence under "the trial judge's admirable exposition of patent law" (admirable, not less in respect of

that issue, than of all other issues), and rendered its verdicts on that issue as well as on all other issues.

These things, but more probably Judge LaBuy's memorandum denying respondent's motion for a new trial and for judgment notwithstanding the verdicts (*supra*, pp. 3-4), may explain why the Circuit Court of Appeals did not tamper with the jury's verdicts, by resorting to the "scintilla" rule, which Judge LaBuy so emphatically rejected as here totally inapplicable. Whatever individual judges may think of a jury as being the tribunal best equipped to determine patent cases, it is the tribunal authorized to do so in actions at law like the present. *Tucker* v. *Spalding*, 80 U. S. 453, 455, *supra*.

Our first Congress in the first Patent Act of 1790 made a jury the only tribunal to hear patent cases. It was not until 1819 that a later Congress permitted an equity judge to hear such cases. *Root* v. *Railway Co.*, 105 U. S. 189, 191-2. Rule 50 of the Rules of Civil Procedure has not taken from juries and conferred upon judges the power to weigh evidence and determine contested issues of fact. A jury is still the constitutional tribunal for trying facts in courts of law. *Berry* v. *U. S.*, 312 U. S. 450, 453. The appellate court's ignoring of the jury's verdicts herein is comparable to its ignoring the jury's verdict on the ground that an "issue had not been submitted to the jury" in *U. S.* v. *Socony-Vacuum Oil Co.*, 310 U. S. 150, 211, in which this Court reversed the same appellate court. In the latter case there was the further circumstance that the appellate court had been factually correct, as it is not herein, in saying that the jury did not consider the particular issue.

Where, as here, the respondent failed to assign error by the trial judge in any admission or exclusion of evi-

dence or in any instruction or lack of instruction to the jury, or to object to any instruction or to request any further instruction, the appellate court may not speculate or substitute its own judgment with respect to a fact which is concluded by the jury's verdict. As stated in *Tennant* v. *Peoria & P. U. Ry. Co.*, 321 U. S. 29, 33 (reversing the Circuit Court of Appeals for the Seventh Circuit): "No court is then justified in substituting its conclusions for those of the twelve jurors." That such is the law, as stated in the decisions of this Court, is indisputable. That the opinion of the court below is squarely in conflict with such decisions is plainly manifest by mere comparison.

The court below held:

> "As we view the record there has been no determination of the validity of the claims, as to their sufficiency under the statute, unless such conclusion be inherent in a verdict and judgment of recovery against the defendant. We conclude that where, as here, there was no instruction on the matter, the issue was ignored and therefore must be determined by this court." (R. IV, p. 2781.)

To the contrary, this Court has held in a frequently cited patent case:

> "In the argument at the bar, much reliance has been placed upon this evidence by the counsel for both parties. It has been said, on behalf of the defendants in error, that it called for other and explanatory directions from the court, and that the omission of the court to give them in the charge, furnishes a good ground for a reversal, as it would have furnished in the court below for a new trial.

But it is no ground of reversal, that the court below omitted to give directions to the jury upon any points of law which might arise in the cause, where it was not requested by either party at the trial. It is sufficient for us, that the court has given no erroneous directions. If either party deems any point presented by the evidence to be omitted in the charge, it is competent for such party to require an opinion from the court upon that point; if he do not, it is a waiver of it.

The court cannot be presumed to do more, in ordinary cases, than to express its opinion upon the questions which the parties themselves have raised at the trial."

Pennock v. *Dialogue*, 27 U. S. 1, 15.

Likewise:

"It is insisted, in this connection, that the reissue is void, because it was not for the same invention as the original patent [R. S. 4916, 35 U. S. C. 64].

This point does not appear to have been taken in the court below, and, therefore, cannot be made here. No instruction was asked or given touching the subject. It is to be presumed, until the contrary is made to appear, that the commissioner did his duty correctly in granting the reissued patent."

Klein v. *Russell*, 86 U. S. 433, 463.

See also:

Texas & Pacific Ry. Co. v. *Volk*, 151 U. S. 73, 78;
Humes v. *United States*, 170 U. S. 210, 211-2.

To an equal extent the opinion below circumvents Rule 51 of the Rules of Civil Procedure, which states in part:

> "No party may assign as error the giving or the failure to give an instruction unless he objects thereto before the jury retires to consider its verdict, stating distinctly the matter to which he objects and the grounds of his objection."

It will be remembered in the case at bar that respondent made no objection whatever to the charge. It requested no further instruction. On appeal before the court below respondent raised no point that the trial judge had erred in any admission or exclusion of evidence or any instruction or lack of instruction to the jury.

The writ prayed should be granted to resolve the plain conflict above indicated. The Court has recognized discrepancy between decisions of circuit courts of appeal and the decisional law of this Court as reasons for granting certiorari, and reversal in:

> *McCormick* v. *Burnet*, 283 U. S. 784;
> *Massey* v. *United States*, 291 U. S. 608;
> *Marine Bank* v. *Kalt-Zimmers Co.*, 293 U. S. 357, 366.

4. After the case at bar was submitted to the Circuit Court of Appeals the opinion of this Court was rendered in *Halliburton Oil Well Cementing Co.* v. *Walker*, 329 U. S. 1. That case was on writ of certiorari to the Circuit Court of Appeals for the Ninth Circuit. This Court held:

> "We understand that the Circuit Court of Appeals held that the same rigid standards of description

> required for product claims is not required for a combination patent embodying old elements only. We have a different view". (329 U. S. at p. 9).

This Court further held:

> "It is urged that our conclusion is in conflict with the decision of *Continental Paper Bag Co.* v. *Eastern Paper Bag Co.*, 210 U. S. 405. In that case, however, the claims structurally described the physical and operating relationship of all the crucial parts of the novel combination. The Court there decided only that there had been an infringement of this adequately described invention". (329 U. S. at p. 13).

The similar view of the Circuit Court of Appeals for the Seventh Circuit had theretofore been stated in *Gilchrist Co.* v. *Kar-Lac Co.*, 29 F. (2d) 153, 154, as follows:

> "That some of the elements of the combination are claimed in terms of 'means' defined in terms of function is not objectionable in combination claims."

In support of this holding the court cited this Court's earlier decision in the *Continental Paper Bag* case.

In the case at bar the court below has now interpreted the decision of this Court in the *Halliburton* case in a manner inconsistent with the opinion of this Court in the *Continental Paper Bag* case.

In the *Halliburton* case, the patentee had added a particular single element to an *old combination*. The addition made certain echoes "more prominent on the graph and easier to count" (329 U. S. 1 at p. 7). There was a difference in degree of result but no new combination to furnish

a new kind of utility or result.[4] In the case at bar patent No. 2,056,165 (R. IV, pp. 2686-91) is for a unitary household refrigerator comprising in combination two differentially insulated food storage chambers, one cooled by a coil having an exposed surface above 32°F. (non-frosting) and the other by a coil having an exposed surface substantially below 32°F. (freezing). These elements were well known individually or in different association long before the present patentees' invention. But no item of the prior art disclosed their association in the patentees' particular (and new) unitary combination. The patentees' invention afforded greatly improved food preservation in the home and, on respondent's evidence, has greatly advanced the domestic refrigerator industry (R. I. p. 151; R. III, pp. 1990, 1994, 2009, 2013). The patent claims are directed to a *particular new and improved combination* of elements and not to any particular new or improved elements and not to any ultimate functional result.

The court below has mis-interpreted the decision of this Court in the *Halliburton* case as a wholesale condemnation of patent claims couched in language calling for a combination of cooperating elements unless the claims verbally restrict the elements by definition to the particular embodiments of each chosen by the inventor to illustrate his preferred embodiment of his combination invention. This is precisely the point on which Mr. Justice Frankfurter reserved judgment.

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[4] The Court had found:

"The Lehr and Wyatt instrument could record all these echo waves" (329 U. S. 1, 6).

The *Halliburton* case has already occasioned wide spread concern to the patent bar.[5] The mis-interpretation of that decision by the court below, if generally applied, would require the wholesale invalidation of the majority of patents covering inventions which reside in new combinations of individually old elements, and the more basic and valuable such inventions might be the more certainly would the patents therefor be vitiated or restricted in scope to a minimal value.

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[5] See Journal of the Patent Office Society, February 1947, Vol. XXIX No. 2, pages 105-135:

Halliburton Oil Well Cementing Co. v. Walker.
71 USPQ 175

A Technical Knockout

By Albert M. Zalkind

"In a decision dated Nov. 18, 1946, the Supreme Court handed down a decision in the case of *Halliburton* vs. *Walker* which bids to cut deeply into the heart of patent rights; a decision which if rigidly followed would not only bring about a drastic change in Patent Office policy as to 'single means clauses' but which would make the drawing of generic claims in some cases well nigh impossible."

* * *

"A decision which strikes down the instant patent and which reaches forward to stunt patents as yet unborn, and which reaches back to benight patents forming the basis of existing license agreements or under the protection of which many an entrepreneur is risking his time and his capital is a decision that appears to go far beyond the spirit and intent of R. S. 4888."

* * *

"CONCLUSION:

* * * The chaos in which the present decision throws the law will be felt for some time, and altho' the writer does not contend that established rules are necessarily sacred and must never be upset, nevertheless there must be some understanding and consideration given to the effect of upsetting patent doctrines which in many cases only specialists in patent law would be able to perceive."

The *Halliburton* decision has already been divergently applied by the court below (*supra*, p. 9). The uncertainty of its intended scope and applicability presses on all trial and appellate courts in patent cases. The peril of irremedial injury in particular cases calls for clarification now without awaiting further conflict of interpretation which has already begun.

Conclusion

It is submitted that the writs prayed for should be granted.

Respectfully submitted,

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Counsel for Petitioners.

ELMER R. HELFERICH,
GEORGE A. CHRITTON,
of Counsel.

April 21, 1947.

APPENDIX

R. S. 4888, 35 U. S. C. §33

Before any inventor or discoverer shall receive a patent for his invention or discovery he shall make application therefor, in writing, to the Commissioner of Patents, and shall file in the Patent Office a written description of the same, and of the manner and process of making, constructing, compounding, and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art or science to which it appertains, or with which it is most nearly connected, to make, construct, compound, and use the same; and in case of a machine, he shall explain the principle thereof, and the best mode in which he has contemplated applying that principle, so as to distinguish it from other inventions; and he shall particularly point out and distinctly claim the part, improvement, or combination which he claims as his invention or discovery. The specification and claim shall be signed by the inventor. No plant patent shall be declared invalid on the ground of noncompliance with this section if the description is made as complete as is reasonably possible.